

Appl. No. 09/845,473
Response dated February 11, 2005
Response to final Office action of October 29, 2004

Amendments to the Drawings:

The attached sheets of drawings include changes to Figures 3, 5, 7, 8, 10, and 16-18. These sheets replace the original sheets that included Figures 3, 5, 7, 8, 10, and 16-18. Applicant requests that these drawing amendments be approved.

Attachment: Replacement Sheets

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REMARKS/ARGUMENTS

In amended Figures 5, 7, 8, 10, and 16, the previously omitted element numerals 162a,b, 102a,b, 122a,b, 166a, 168; 402 and 404 have been added. Numerals have been added to Figures 17-18. No new matter has been added.

Claims 1-11 remain in this application. The examiner acknowledged that claim 10 is directed to allowable subject matter. Claims 12-14 have been withdrawn as the result of an earlier restriction requirement. In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 12-14 in a divisional application.

I. DRAWINGS

The examiner objected to the drawings stating that Figures 16-18 do not contain any reference numbers that the examiner considers necessary for a complete understanding of the claimed invention. Applicant has added reference numerals 403 and 404 to Figure 16 and has added reference numerals to Figures 17 and 18 based on the disclosure from pages 11-16 of U.S. Provisional application No. 60/201,193, filed May 2, 2000 and entitled Traction Module incorporated by reference in paragraph [057] in the present application. New paragraphs [057.1]-[057.10] from pages 11-16 of U.S. Provisional application No. 60/201,193, filed May 2, 2000 and entitled Traction Module incorporated by reference in paragraph [057] in the present application have also been added for the description of the newly added reference numerals. No new matter has been added. In view of these amendments, Applicant respectfully submits that Figures 16-18 are now in proper form.

The examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) stating that they do not include the following reference signs mentioned in the description: 102a, 102b, 122a, 122b, 140a, 140b, 142a, 142b, 162a, 162b, 158a, 158b, 166, 124, 118, 158, and 402.

Applicant amends the drawings and the specification as above in accordance with the examiner's objections. Reference numeral 162 in Figure 5 has been changed to 162a,b. Reference numerals 102a,b have been added to Figure 7 and Reference numerals 122a,b have been added in Figure 8. Likewise reference numerals 168 and 166a have been added to Figure 10. The specification has been amended to refer to reference numeral 140 and 142 instead of 140a,b and 142a,b so that the specification conforms to the drawings. Likewise the specification has been amended to reference numerals 124a,b, 118a,b, 158a,b, and 166a,b. Applicant respectfully submits that the drawings are now in proper form.

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The examiner objected to the drawings as failing to comply with 37 CFR 1.84(p)(5) stating that they include the following reference signs not mentioned in the description: 152 and 168.

Applicant respectfully submits that paragraph [0035] describes reference 152 by stating, "It can be seen in assembling end member 78 and medial member 82, end 150 of end member 78 is aligned with end 152 of medial member 82 such that the track pair 98 is aligned with track pair 140 such that end member 78 is slid onto medial member 82."¹ Paragraph [0037] by stating "Medial member 82 has recesses, such as recess 168, for housing one end of springs 166."² Applicant respectfully submits that the drawings are in proper form.

II. CLAIM REJECTIONS – 35 USC § 102

A. Examiner's Statements

Examiner rejected claims 1-8 and 11 under 35 U.S.C. § 102(b) as being anticipated by Semar (U.S. Patent No. 4,542,788).

B. Law

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.³ The identical invention must be shown in as complete detail as is contained in the ... claim.⁴

C. Claims 1 - 8

Semar does not anticipate claims 1-8, as amended, because Semar does not disclose first and second tapered members and a camming member where the first and second tapered members are axially spaced along the longitudinal axis of the camming member with the camming member disposed axially between said first and second tapered members. Semar discloses a set of slips 24 disposed on either radial side of a tapered cone 22. However, Semar does not disclose that the slips 24 are oppositely disposed on a camming member that is disposed between the slips 24 in the axial direction related to the longitudinal axis of the tool. In fact, Semar only discloses axial symmetry with the slips being axially aligned on either side of the tapered cone 22. Thus, Semar never discloses first and second tapered members as required by claims 1-8. Applicant therefore respectfully submits that rejection is unsupported by the art and requests that the examiner withdraw the rejection. Further,

¹ Emphasis added.

² Emphasis added.

³ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

⁴ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

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Seman does not disclose an anchor member for anchoring to a borehole wall. Seman is directed to an anchor for anchoring to the inside of casing.

D. Claim 11

Seman does not anticipate claim 11 because Semar does not disclose a double sided wedge device to actuate an extendable member, the double sided wedge device comprising first and second tapered surfaces on opposite sides along the longitudinal axis of the double sided wedge device. Semar discloses a set of slips 24 disposed on either radial side of a tapered cone 22. However, Semar does not disclose that the tapered cone 22 has first and second tapered surfaces that are on opposite sides of the tapered cone 22 in the axial direction of the longitudinal axis of the apparatus. In fact, Semar only discloses that the tapered surface of the cone 22 is on "opposite sides", if a cone can be said to have more than one side, in the radial direction, not the axial. Thus, Semar never discloses first and second tapered surfaces as required by claim 11. Applicant therefore respectfully submits that rejection is unsupported by the art and requests that the examiner withdraw the rejection.

III. CLAIM REJECTIONS - 35 U.S.C. § 103

A. Examiner's Statements

The examiner rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Semar (U.S. Patent No. 4,542,788) in view of Baker (U.S. Patent No. 2,878,877).

B. Law

MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.⁵ Second, there must be a reasonable expectation of success.⁶ Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.⁷ The teaching or

⁵ MPEP § 2142.

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⁷ MPEP § 2142.

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suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.⁸

C. Claim 9

Claim 9 is not obvious because Semar combined with Baker fails to teach or suggest all of the limitations of the claims. Applicants also repeat the arguments made above for the patentability of claim 1. As claim 9 depends from claim 1, applicant respectfully submits that claim 9 is also patentable. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claim 9.

IV. ALLOWABLE SUBJECT MATTER

The Examiner stated that claim 10 is allowable.

CONCLUSION

Applicant respectfully requests reconsideration the pending claims and that a timely Notice of Allowance be issued in this case. If the examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned.

In the course of the foregoing discussions, applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. There may also be other distinctions between the claims and the prior art that have yet to be raised, but that may be raised in the future.

Unless Applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although Applicant may have amended certain claims, Applicant has not abandoned its pursuit of obtaining the allowance of these claims as originally filed and reserves, without prejudice, the right to pursue these claims in a continuing application.

⁸ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley Rose, P.C. Deposit Account Number 03-2769 (ref. 1391-19601) of Conley Rose, P.C., Houston, Texas.

Respectfully submitted,
CONLEY ROSE, P.C.



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Attachments